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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09/512,592	02/23/00	DICKENS	2039-301

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EXAMINER

JEAN HOMERE

ART UNIT	PAPER
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2177

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DATE MAILED: APRIL 16, 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/512,592

Applicant(s)

DICKENS, BRUCE M.

Examiner

Jean R. Homere

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

APR 16 2003

DETAILED ACTION

1. The Examiner has carefully reviewed Applicant's arguments and Expert's declaration submitted on 12/23/2002. The arguments are not deemed persuasive and declaration is not effective to overcome the rejections of record. Consequently, the Examiner hereby repeats and incorporates by reference the rejections of claims 1-76 (paper no. 22, mailed on 07/22/02) as well as the remarks thereto. The rejection of claims 1 through 76 are hereby sustained and are made **FINAL**. Pursuant to section IV of the decision to merge the Reissue and Reexamination proceedings (Paper no. 10), the period of response is set at two (2) months.

2. Applicant argues that while Shaughnessy, Hazama, Ohms and Booth disclose the use of windowing, they disclose different solutions from applicant's to the Y2k problem in legacy databases. Applicant's characterization of the references is inaccurate. The solutions to the Y2k problem in legacy databases offered by the cited references are very similar to Applicant's solution to the point that they render it obvious. The similarities between Applicant's solution and the prior art are discussed in detail in the 103 rejections above. Applicant also argued that the rejection of claims 1-76 under 35 USC 112 is improper. Applicant's contentions are not supported by the original specification. The deficiencies in claims 1-76 are detailed in the 112 rejections above. Applicant's remarks regarding the rejections of record will be particularly addressed starting in paragraph 4 below.

103 Rejections

3. In the section entitled "The Examiner's Rejections", starting at page 29, Applicant argues that Examiner's general comments about Shaughnessy and Hazama are inappropriate because they do not refer to a statute and do not refer to relevant column or page number(s) and line number(s) where appropriate. The general comments about Shaughnessy and Hazama are not particularly intended as a rejection of the claimed invention. They are presented as a way to offer an overview of how the references generally obviate the claimed invention. Applicant should therefore regard these comments as a prelude to the 103 rejections of the claimed invention over the cited references. In the following paragraphs, the Examiner will consequently address Applicant's contentions in the order which they appear in the response, and to the extent that they relate to the rejections of record.

4. Applicant argues that Shaughnessy does not "suggest [] the conversion of all dates within the database from a two digit format to a four digit format as a viable, but costly alternative for the year 2000 problem (col. 1, line 31-46). In the cited passage, Shaughnessy is either saying that as to a legacy database it is difficult and expensive to modify the format, fields for the database to only include 4 character date representations... and that Shaughnessy teaches a separate way than the claimed invention to solve this problem, and thereby teaches away from the claimed invention. Applicant's interpretation of the cited passage is inaccurate. The cited passage states in relevant-part:

One solution to this problem would be to **convert all dates within the application system** of the computer to use date fields with **four digit representations for the year**. This is however a relatively

expensive solution for a variety of reasons. First, this solution requires the creation and testing of programs **to convert all date fields in all applications files**. (Emphasis added)

From the cited portions above, it is clear that Shaughnessy is suggesting that **converting all dates within the database** from a two digit format to a four digit format is a possible solution to the Y2k problem. Although Shaughnessy recognizes the economic and technological difficulties that such a solution might entail, it nonetheless acknowledges such approach as a solution to the Y2k problem before the present invention was made. Consequently, one of ordinary skill at the time of the present invention would have been motivated to explore this solution as proposed by Shaughnessy despite of the constraints noted therein. Thus, the claimed invention of converting dates in a database from a two digit to a four digit format achieves essentially nothing other than what Shaughnessy suggested in the cited portion of the reference.

5. Applicant argues that Shaughnessy's disclosure of a date having a cycle or a range of a 100 years, in column 18, which states 'Cycle/Range C1 = THE DATE CYCLE IS A 100 YEARS' is not equivalent to the claimed 'all of the symbolic representations of dates falling within a 10 decade period of time' because Shaughnessy discloses other date ranges as well. Applicant's interpretation is misleading. The fact that the reference can support a plurality of date ranges including a 100 year range does not preclude it from actually suggesting that the dates falling within the 100 year range can be utilized as a window in the invention. In fact, such disclosure should testify to the versatility of the reference since it is intended to suggest that any of the cited date ranges can be utilized as a range for dates falling therein. Additionally,

Shaughnessy specifically suggests the use of the 100 year date range in determining the two possible century values of dates in a database (see figures 2 and 4, item 16). Therefore, Shaughnessy does teach and suggest the claimed 'all of the symbolic representations of dates falling within a 10 decade period of time.'

6. Applicant argues that while Shaughnessy discloses a form of windowing using the install date as the pivot date, said windowing is not disclosed to be done for each symbolic representation of a date in the database in preparation for and facilitation of further processing of the reformatted symbolic representations. Such contentions are unfounded. Shaughnessy, in column 7, lines 7-15, particularly discloses the comparison of each date in the database with the corresponding portion of the end of the 100 year cycle date. Depending on whether said date is less than or equal to or greater than the end of the 100 year cycle date, a century value C1 or C2 is attached to the date, thereby reformatting the date to a YYYYMMDD format, which corresponds to applicant's claimed C1C2Y1Y2M1M2D1D2 date format. Shaughnessy particularly refers to conversion of dates not just a single date in the database as erroneously contended by applicant (see column 6, lines 60-65). Since the disclosed windowing is part of the conversion process for each date, therefore, said windowing process performed for each date in the database.

7. Additionally, applicant contends that Shaughnessy does not teach that the use of reformatted dates to "facilitate further processing of the dates." Although applicant concedes that Shaughnessy teaches the return of a parameter to the application program, wherein said

parameter is indicative of the result of the date operation having been performed, applicant nonetheless argues that said parameter is not the reformatted date. The Examiner respectfully disagrees. Applicant incorrectly relied on certain column 4, lines 59-61 of the reference to support his arguments. The subroutine being discussed in the cited textual portions upon which applicant relies have nothing to do with the date conversion in the textual portions of column 2 discussed above. Applicant should note that while Shaughnessy discloses a plurality of subroutines, which are called and returned to the application program, all the subroutines are not specifically concerned with date conversion. See generally column 4. As conceded by applicant, Shaughnessy clearly indicates that the parameter returned to the application program can be either 'a *date field* or a code indicative of a result of the date operation having been performed.' See column 2, lines 37-40. Applicant, however, failed to heed to the fact that the returned parameter can be a *date field* (i.e. capable of having date entries therein). Consequently, the return of the date field may contain reformatted dates that can be used to facilitate further processing as suggested by Shaughnessy in column 2, lines 45-54.

8. Applicant also argues that Shaughnessy does not disclose a very specific way of selecting a one hundred year window, which is based on the earliest date in the database. Therefore, the Examiner's conclusory statement that the ordinary skilled artisan would "immediately see" is flawed and needs motivation. Applicant's arguments clearly mischaracterize the teachings resulting from the Shaughnessy-Hazama combined system, and offer a piecemeal analysis of the references. In response to applicant's arguments against the references individually, Applicant is reminded that one cannot show nonobviousness by

attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, in response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Shaughnessy suggests selecting the 100 year decade based on the system date, which is earlier than any other date in the database (col.7, lines 6-20), while Hazama teaches selecting the pivot date for the 100 year window, wherein said pivot date is lower than all other dates in the database. Therefore, the motivation is proper since Shaughnessy suggests the concept of selecting the 100 year window based on the current system date, and Hazama further expands on the teaching suggested by Shaughnessy (i.e. see the need to combine the references). Thus, the ordinary skilled artisan would have found obvious to look to analogous art in the data processing technology for similar teachings to reinforce the Y2k solution proposed by the Shaughnessy reference thereby complementing it. Consequently, the rejection of claim 1 is sustained.

9. Regarding the rejection of claim 9, Applicant essentially argues that the cited portions of Shaughnessy do not teach the storing¹ of reformatted dates in the database. The Examiner submits that it should be apparent from the cited textual portions of Shaughnessy relied upon in the rejection of claim 9, as well as the foregoing discussions, that the reformatted dates are necessarily already stored in the date field returned by the subroutine, wherein said date field is forwarded to the application program for further processing. Thus, the Examiner was correct in taking the position that the solution of storing the symbolic representations back in the database is taught by Shaughnessy as the available and inevitable solution. Consequently, the rejection of claim 9 is sustained.

10. Regarding the rejection of claims 2, 3, 5, 7 and 10, Applicant primarily relies on their dependency on claim 1 to allege that they are patentable over the prior art of record since claim 1 is allegedly patentable. Additionally, with respect to each of the cited claims, Applicant generally alleged that the prior art does not teach each and every claimed limitation without actually detailing the reasons why. In response to such allegations, the Examiner submits that rejection of claims 2-, 3, 5, 7 and 10 is sustained since claim 1 was properly rejected over the

¹ In the remarks filed on 4/2/1998, paper 9, Applicant argued in-part that: "The method of the claimed invention encompasses embodiments in which the date information is initially reformatted and converted to have century designations, but does not require that the reformatted dates be stored. For example, the method of one embodiment of the claimed invention reads the dates from the database and temporarily reformats the dates, such as sorting the dates. However, once the data manipulations are complete, the reformatted dates need not be stored in the data storage. Instead the dates in the data storage can remain the same as they were prior to the temporary reformatting of the date information. Thus, the method of this embodiment of the claimed invention does not require additional data fields for storage because the reformatted dates with century designations are only used "on the fly" for data manipulation and are not stored in the data storage." (Emphasis added).

In consequence, notwithstanding the reference to item 36 in the specification, item 36, which purported to reformat dates in the database, was deleted from figure 2, as originally filed. Now, Applicant seems to go to great length in an attempt to reconcile the cited amendment with the invention, as presently claimed. Such explanation, however, offers little assistance.

Shaughnessy and Hazama combination, as laid out in the office action of 7/22/2002 and as discussed in the foregoing remarks. Additionally, Applicant is reminded that pursuant to 37 CFR 1.111(b), a general allegation that the claim define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the prior art of record is insufficient to rebut a prima facie case. Applicant simply alleges that the limitations of the cited claims are not taught by Shaughnessy and Hazama. However, Applicant failed to actually explain how these limitations are distinguishable from the textual portions of the cited references on which the Examiner relied to establish the prima facie case.

Consequently, Applicant has failed to successfully rebut the rejection of the cited claims. It has also been held that Applicant bears the burden of explaining why the evidence on which the Examiner relies is insufficient to establish a prima facie case or demonstrating that Applicant has provided evidence, which rebuts the prima facie case. See *In re Rouffet*, 149 F.3d 1350, 1355 47 USPQ2d 1453, 1455 (Fed. Cir. 1998).

11. Regarding the rejection of claims 4, 6, 8 over Shaughnessy, Hazama and Booth, Applicant generally reiterates that Booth is non-analogous art since it allegedly does not seek to solve the Y2k problem. Applicant's interpretation of the Booth reference is simply erroneous. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the textual portions of the Booth reference relied upon in the rejection of the cited claims are particularly concerned

with converting two digit year dates to four digit year dates (see e.g. SET EPOCH, P 941).

Booth states in relevant-part:

“When a two digit year is entered into a date, its year digits are compared with the year digits of the epoch setting to determine the century to place the date into. If the two digits are prior to the setting of the SET EPOCH, the year is assumed to be in the next century. If the digits are greater than or equal to the SET EPOCH setting, the year is assumed to be in the current century.”

Clearly, the foregoing portion of Booth is concerned with solving the Y2k problem in the manner proposed by Applicant, Shaughnessy and Hazama. That is, Booth's solution is intended to resolve any possible confusion that could result between dates falling between the 20th and the 21st centuries. Therefore, the Booth reference is within the field of applicant's endeavor since it sought to solve the same problem with which applicant was concerned.

12. Applicant admits that Booth does teach windowing using a ten-decade window, but alleges that said window is not offered in the context of the claimed invention (e.g. not for facilitating further processing of dates). Applicant further alleges that Booth does not teach reformatting and sorting the dates. However, Applicant fails to address the particular portions of Booth relied upon for the cited limitations. The office action made it clear that Booth teaches the conversion of two digit year dates to four digit year dates, whereby said four digit year dates are sorted. Applicant's failure to particularly detail how the claimed limitations are distinguished over the cited portions of Booth is not in conformance with 37 CFR 111(b) and the controlling case law. In consequence, Applicant failed to successfully rebut the prima facie case. The rejection of claims 4, 6 and 8 is hereby sustained.

13. Regarding the rejection of claims 11-15, Applicant defers to the arguments presented for claims 4, 6 and 8 to allege that claims 11-15 are patentable over the prior art of record. The Examiner submits that, similarly, the arguments offered in the preceding paragraphs clearly show that a prima facie case was properly established and that applicant failed to successfully rebut it. Consequently, the rejection of claims 11-15 is hereby sustained.

14. Regarding the rejection of claims 16-18, 20, 22, 24-25, applicant defers to the arguments offered for claim 1 to allege that claims 16-18, 20, 22, 24-25 are patentable over the prior art of record. The Examiner submits that, similarly, the arguments offered in the preceding paragraphs clearly show that a prima facie case was properly established and that applicant failed to successfully rebut it. Consequently, the rejection of claims 16-18, 20, 22, 24-25 is hereby sustained.

15. Regarding the rejection of claims 19, 21 and 23, applicant defers to the arguments offered for claims 4,6 and 8 to allege that claims 19, 21 and 23 are patentable over the prior art of record. The Examiner submits that, similarly, the arguments offered in the preceding paragraphs clearly show that a prima facie case was properly established and that applicant failed to successfully rebut it. Consequently, the rejection of claims 19, 21 and 23 is hereby sustained.

16. Regarding the rejection of claims 26-30, applicant defers to the arguments offered for claims 11-15 to allege that claims 26-30 are patentable over the prior art of record. The Examiner submits that, similarly, the arguments offered in the preceding paragraphs clearly show

that a prima facie case was properly established and that applicant failed to successfully rebut it.
Consequently, the rejection of claims 26-30 is hereby sustained.

17. Regarding the rejection of claims 31-33, applicant defers to the arguments offered for claims 1, 11 and 16 to allege that claims 31-33 are patentable over the prior art of record. The Examiner submits that, similarly, the arguments offered in the preceding paragraphs clearly show that a prima facie case was properly established and that applicant failed to successfully rebut it. Consequently, the rejection of claims 31-33 is hereby sustained.

18. Regarding the rejection of claims 34-59, applicant defers to the arguments offered for claims 1 and 16 to allege that claims 34-59 are patentable over the prior art of record. The Examiner submits that, similarly, the arguments offered in the preceding paragraphs clearly show that a prima facie case was properly established and that applicant failed to successfully rebut it. Consequently, the rejection of claims 34-59 is hereby sustained.

19. Regarding the rejection of claims 60-71, applicant defers to the arguments offered for claims 1 and 4 to allege that claims 60-71 are patentable over the prior art of record. The Examiner submits that, similarly, the arguments offered in the preceding paragraphs clearly show that a prima facie case was properly established and that applicant failed to successfully rebut it. Consequently, the rejection of claims 60-71 is hereby sustained.

20. Regarding the rejection of claims 72, 73 and 75, applicant defers to the arguments offered for claims 4, 6, 13 and 14 to allege that claims 72, 73 and 75 are patentable over the prior art of record. The Examiner submits that, similarly, the arguments offered in the preceding paragraphs clearly show that a prima facie case was properly established and that applicant failed to successfully rebut it. Consequently, the rejection of claims 72, 73 and 75 is hereby sustained.

21. Regarding the rejection of claims 74 and 76, applicant defers to the arguments offered for claims 1 and 4 to allege that claims 74 and 76 are patentable over the prior art of record. The Examiner submits that, similarly, the arguments offered in the preceding paragraphs clearly show that a prima facie case was properly established and that applicant failed to successfully rebut it. Consequently, the rejection of claims 74 and 76 is hereby sustained.

22. Regarding the rejection of claims 1-76 over Ohms in view of Hazama, and as to some claims in further view of Booth, Applicant defers to the arguments presented in the previous response, paper no. 20. In the last office action, the Examiner fully addressed applicant's arguments and sustained the rejection of these claims over Ohms, Hazama and Booth (See paper no. 22). In addition, Applicant is now arguing that Ohms' disclosure of a method for processing dates outside the twentieth century is not equivalent to the claimed 'method of processing symbolic representations of dates stored in a database' because the dates in Ohms' database are allegedly represented in Lillian format, and poses no Y2K ambiguity. In response to the preceding arguments, the Examiner respectfully submits that as pointed out in the remarks section of the last office action, the representation of dates in the Ohms reference is not limited to a Lillian

format. In table 1, page 247, Ohms indicates that dates are stored in the database in Gregorian format to unambiguously convert six digit dates into unambiguous eight digit dates, thereby resolving the Y2K problem.

23. Applicant also argues that Ohms does not disclose the storing of dates to be within a ten-decade window because it suggests a variety of date ranges. Applicant also argues that Ohms does not disclose selecting the ten-decade window based upon dates actually stored in the database. This reading of the Ohms reference is inaccurate. The fact that Ohms discloses a variety of date ranges including the ten-decade window does not imply that it teaches away from using the ten as a particular date range. In fact, Ohms specifically proposes the ten-decade window as an excellent choice for the date conversion. See page 248, right hand column, and 2nd paragraph. Further, Ohms discusses at page 249, in the paragraph entitled "Computational Considerations" the storage requirements for maintaining dates in the different formats in the database. Consequently, Ohms does disclose the cited limitations.

24. Applicant generally reiterates that Ohms is non-analogous art since it allegedly does not seek to solve the Y2k problem since it stores dates in a Lillian format. Applicant's interpretation of the Ohms reference is simply erroneous. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the textual portions of the Ohms reference relied

upon in the rejection of the cited claims and in the preceding remarks are particularly concerned with converting two digit year dates to four digit year dates (see e.g. table 1, page 247) where Ohms teaches the conversion of a short Gregorian format (YYMMDD) date into a Gregorian date format (MMDDYYYY). Further, at page 248, last paragraph of the first column, Ohms states in relevant-part:

“End users usually enter two digits for the year in a date and understand the ambiguity that this represents... entry of all four digits may be required.”

Clearly, the foregoing portions of Ohms are concerned with solving the Y2k problem in the manner proposed by Applicant and Hazama. That is, Ohms' solution is intended to resolve any possible confusion that could result between dates falling between the 20th and the 21st centuries. Therefore, the Ohms reference is within the field of applicant's endeavor since it sought to solve the same problem with which applicant was concerned.

25. Applicant defers to the arguments presented in the prior response to rebut the rejection of claims 16-76 over Ohms in view of Hazama and further in view of Booth for some claims. The Examiner submits that a prima facie case was properly established in the last office action, and Applicant's arguments were traversed in the Remarks section of the office action. Consequently, the Examiner's remarks regarding applicant's arguments are herein incorporated by reference, and the rejections of claims 1-76 over the Ohms, Hazama and Booth combination are proper and are hereby sustained.

35 U.S.C. 112 Rejections

26. Applicant argues that the 112 rejections presented in last office action should have been made in the first office action in this merged reissue proceeding to give applicant an opportunity to address them twice. Applicant's arguments are spurious at best, and have no legal basis to support the contention that he should have been allowed to address the rejection in the prior response. The rejections were made in a non-final action. Thus, applicant was not denied an opportunity to respond to the rejection.

27. Applicant cites to sections 608.01 and 608.04 of the MPEP to support the contention that the new matter rejection of claims 16-67, 69-73, 75-76 is improper because there has been no amendment to the descriptive portion of the specification. MPEP 608.01 (I) states:

*In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it. **Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter.** The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim. It is, of course, to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and description. (Emphasis added)*

Section 608.04 (I) reproduced in the text hereinabove indicates simply that subject matter in the original description, claims, and drawings can be relied upon to show that applicant was in possession of the invention at the time of filing.

Further, MPEP 608.04(a) states in relevant-part:

Matter not in the original specification, claims, or drawings is usually new matter. (Emphasis added)

Additionally, MPEP 608.04(f) states in relevant-part:

*No amendment may introduce new matter in the disclosure of an application
When new matter is introduced into the specification, the amendment should be objected
to under 35 U.S.C. 132 (35 U.S.C. 251 if a reissue application) and a requirement made
to cancel the new matter. The subject matter, which is considered to be new matter must
be clearly identified by the examiner. If the new matter has been entered into the claims
or affects the scope of the claims, the claims affected should be rejected under 35 U.S.C.
112, first paragraph, because the new matter is not described in the application as
originally filed. (Emphasis added)*

None of the MPEP sections reproduced hereinabove supports applicant's position that only if the descriptive portion of the specification is amended can a new matter rejection be proper.

Pursuant to sections 608.01 and 608.04 (a), matter recited in newly added claims 16-67, 69-73, 75-77 that are not supported by the original disclosure, the original claims or the original drawings should be deemed as new matter. Consequently, the rejection of claims 16-67, 69-73, 75-77 based upon new matter is proper and is hereby sustained. See MPEP 608.04(f).

28. Applicant argues that the rejection of claims 32 and 69 under 35 U.S.C. 112, 2nd paragraph is improper because the disclosure of sorting in a C1C2Y1Y2M1M2D1D2 format would enable one of ordinary skill in the art to realize that sorting of just the C1C2Y1Y2 portion is possible without undue experimentation. Applicant also argues that the rejection of the cited claims under 35 U.S.C. 1st paragraph is improper as well because it is clear from the specification that applicant was in possession of the invention at the time of filing. In response, the Examiner submits that, as discussed in the office action, the claimed C1C2Y1Y2 format results in a faster sort than the C1C2Y1Y2 M1M2D1D2 format described in the specification. Applicant failed to provide any evidence to support the contention that such disclosed sort would

enable one of ordinary skilled in the art to realize the claimed faster sort. For the same reasons, it is concluded that Applicant was not in possession of the faster sorting scheme at the time of the invention. Consequently, the 35 U.S.C. 112, 1st and 2nd paragraph rejection of claims 32 and 69 is proper and is hereby sustained.

29. Applicant argues that the rejection of claims 33, 60-61, 64-65 and 70 under 35 U.S.C. 112, 2nd paragraph is improper because there is adequate disclosure in the original specification from both a written description and an enabling description perspective. Applicant alleges that the “without modifying” or “without changing” recitations refer to the fact that original dates in the database are not changed. In response, the Examiner submits that it is unclear as to where in applicant’s specification such adequate description and enablement was provided to support the claimed language reformatting date “without modifying” and “without changing” date representations. If by definition reformatting dates means modifying or changing the format/representation of dates, how can applicant’s claimed imitations achieve such reformatting dates without changing the date representations. Such language is likely to confuse the ordinary skilled artisan. The Examiner cannot help but wonders that if such limitations are so material to be included in the claims, why on earth did Applicant not take the time to include them in the original specification. The fact that the specification is devoid of the expressions “without changing” or “without modifying” or any equivalents thereof is prima facie evidence that the specification is non-enabling and that these newly added limitations in the claims are essentially new matter. If Applicant intends for the “without changing” or “without modifying” limitations imply not having to add fields to store the extra two year digits after the date conversion, then the

Examiner submits that the cited claims fail to capture the essence of the invention. Further, the specification does not teach the ordinary skill artisan how to achieve such end without undue experimentation, and Applicant's response failed to point where in the specification adequate support is provided for such interpretation. Therefore, the 112 rejection of claims 33, 60-61, 64-65 and 70 is proper and is hereby sustained.

30. Applicant argues that the rejection of claims 16-30, 32, 34-67, 69-71, 75 and 76 under 35 USC 112 for inadequate disclosure in the original specification to support the limitations "pivot year," or "pivot date" is improper. Applicant alleges that the specification does not need to mention the terms "pivot date" or "pivot year," since they are well-known in the art. In response, the Examiner submits that to the extent that the use of the cited terms in this application were limited to their well-known definition in the art, the specification would not need define them. However, the context in which applicant used the cited terms, as claimed, exceeds the scope of their well-known meaning in the art. Since the specification does not provide any clarification or support for Applicant's tailored used of those terms, the 112 rejection is proper.

31. Applicant argues that the rejection of claims 20-21, 62-65 and 71 under 35 U.S.C. 112 for inadequate disclosure in the original specification to support the claimed limitation of "reformatting or storing separately" from the symbolic representations in the database is improper. Applicant merely alleges that the original specification along with certificate of correction and exhibit A adequately disclosed the cited recitations. Applicant, however, failed to specifically indicate the specific portions of the cited documents where such limitation is

disclosed. Consequently, Applicant failed to successfully rebut the 112 rejection of the cited claims. It is therefore sustained.

32. Applicant argues that the rejection of claims 16-25, 31-33, 66-67, 72 and 36-43 under 35 U.S.C. 112 for inadequate disclosure in the original specification to support the claimed limitations of “collectively further processing” and “collectively sorting or manipulating,” respectively, is improper. Applicant asserts that even though the cited terms are not particularly used in the original specification, it refers to “each” or “all” the of the dates in the database, and that is sufficient to support the cited claimed limitations, and distinguish the invention from Shaughnessy. In response, the Examiner submits that the original specification vaguely refers to “all” dates stored in the database for the purpose of selecting the 10-decade window (col. 3, lines 4-6). This recitation of all the dates in the database has no bearing on processing, sorting or manipulating all the dates in the database, and therefore cannot be relied upon to support such limitations. Consequently, the cited limitations are not supported by the original specification.

33. Applicant argues that the rejection of claims 36-37, 40-41, 48-49, 51-59, 69 and 38, 39, 42-43 under 35 U.S.C. 112 for inadequate disclosure in the original specification to support the claimed limitations of sorting the reformatted dates prior to running a program containing said reformatted dates, and manipulating reformatted dates before running the program containing the reformatted dates, respectively, is improper. Applicant relies on the textual portion in column 3, lines 49-55 of the Dickens patent and exhibit A to provide support for the cited limitations. In response, the Examiner submits that the cited textual portions in Dickens patent discusses

manipulating, (e.g. sorting,) dates after they have been reformatted to thereby store, among other processes, dates back in the database. The cited portion does not, however, involve or suggest running a program containing the reformatted dates after said reformatted dates have been sorted, nor does it teach running a program containing the reformatted dates before manipulating the reformatted dates. Additionally, Exhibit A merely shows a program being sorted prior to printing sorted data. It is not readily discernable from Exhibit A whether the data being sorted consists of the reformatted dates. Consequently, Exhibit cannot be relied upon to support the claimed limitations.

34. Applicant argues that the rejection of claims 46-59 for inadequate disclosure in the original specification to support the claimed limitation of "repeating the step of converting at least a substantial portion" of the specified data is improper. Applicant alleges that the ordinary skilled artisan would have known that the storage of databases may be segmented on pages of extended memory and may therefore run on a substantial portion of a database containing a substantial portion of all the date data fields. Applicant seems to concede that the specification does not provide support for the claimed limitation, but relies nonetheless for support and clarification for such limitation in knowledge that would have been allegedly within the reach of the ordinary skilled artisan. Such reliance on the part of applicant is improper to satisfy the enablement requirements of 35 U.S.C. 112, according to which the specification must fully and clearly disclose the invention such that it can be practiced without undue experiment. In other words, the specification must self-sufficient. Applicant has failed to meet that threshold, and has therefore not provided adequate support in the specification for the claimed limitation.

35. Applicant argues that the rejection of claims 34-65 and 70-71 for inadequate disclosure in the original specification to support the claimed limitation of converting symbolic representations by windowing the symbolic representation is improper. Applicant alleges that although the specification does not particularly provide a definition or support for the term "windowing," it must be construed pursuant to its well-known meaning in the art. The Examiner is unaware of any such well-known use of the term windowing in the art in the context used in Applicant's claims. Since the specification does not clarify or support the use of the term "windowing" in the context used in Applicant's claims, the 112 rejection is proper.

36. Applicant argues that the rejection of claims 35, 37, 39, 41, 43, 45, 49, 51, 53, 55, 57 and 59 for inadequate disclosure in the original specification to support the claimed limitation of "opening a database prior to converting" is improper. Applicant alleges that such sequence of steps is inherent in the disclosure of the Dickens patent, and that it is further supported in exhibit A. The Examiner submits that it is not readily discernable from the codes listed in Exhibit A that the statements "open structure tools: name" and "open #2 : name" have anything to do with the claimed limitation of opening the database prior to converting. Further, the original specification is silent on such limitation, and offers little assistance on how to decipher the codes in Exhibit A, leaving the ordinary skilled artisan with inherency as the sole guide to interpret these terms in the Dickens patent. Applicant is reminded that the allegation of inherency is not a substitute for providing a written description of the invention in such full, clear, concise, and

exact terms as to enable any person skilled in the art to which it pertains. Consequently, the 112 rejection is proper.

37. Applicant argues that the rejection of claims 34-65, 70 and 71 for inadequate disclosure in the original specification to support the claimed limitation of “calling for the avoidance of ambiguity by reformatting or converting date representation” is improper. Applicant cites to column 1, lines 25-35 of the Dickens patent in support of the claimed limitation. The Examiner submits that to the extent that the claimed “ambiguity” is limited to the inability to discern between two digit year dates falling in the 19th and 20th centuries, the cited textual portion does support the claimed limitation.

38. Applicant argues that the rejection of claims 1-15, 31, 33, 68, 72-74 for inadequate disclosure to support the claimed “selection of a YAYB value of a first decade of a window” is improper. Applicant insists that the value of a decade is ten years thereby making a 10-decade window a window of a hundred years. To the extent that the claimed limitation is limited to the foregoing definition, the specification does support said claimed limitation.

Applicant's Response To Examiner's Remarks

39. Applicant reasserts that Shaughnessy does not disclose the claimed step of selecting YaYb no later than the earliest year designator in the database. Applicant cites to column 6, lines 6-22 to submit that Shaughnessy only teaches the end of the 100 year cycle without regard for the earliest date in the database. Applicant's

reliance on the cited textual portion of Shaughnessy to draw such conclusion is erroneous and misleading. The textual portion cited by applicant essentially indicates that the end of the 100-year window is determined based on the current date (lines 15-22). Further, the office action specifically referred to Shaughnessy's suggestion to use the current date as the pivot date of the 100 year window, wherein said current date compares low to all other dates in the database (col. 6, lines 4-5; col. 7, lines 16-17). Therefore, Shaughnessy does suggest the selection of a pivot date to determine the end date of a 100 year window. Additionally, applicant is reminded that the office action relied upon Hazama for its unequivocal teaching of 'a pivot date that is earlier than all other dates in the database' to complement Shaughnessy. Therefore, the claimed limitation of selecting YaYb earlier... was said to be taught by the Shaughnessy-Hazama combination.

40. Applicant argues that the Shaughnessy-Hazama combination does not teach the determination of a century designator for each date in the database. First, applicant asserts that neither reference expressly teaches the step on "each date representation. This argument was fully addressed in paragraph 6 above. Second, applicant argues that even if such teaching is implicit in the cited references, it would not mean that the combined references teach that all dates in the database are converted to facilitate further processing. This is a non-sequitur. The nature of the various solutions to the Y2k problem involves eliminating the date ambiguities between the 19th and 20th centuries such that such converted dates can be properly used in various applications. This is implicit any solution to the Y2k problem. In particular, as discussed

in the office action and in the preceding paragraphs, Shaughnessy's Y2k solution relates to reformatting dates from six digit to 8 digits such that the reformatted dates can be used in subsequent applications. Applicant went on to assert that solutions proposed by Hazama and Shaughnessy are different from that of the claimed invention. This evidence, however, does not support such contention. Applicant is attempting to restrict the date conversions in Shaughnessy to a single instance when the reference is concerned with removing ambiguities between dates of two centuries, and while the reference clearly teaches the conversion of dates. Applicant seems to confuse Shaughnessy's conversion of the dates one at a time with the so-called conversion of a single date. Such misconception on the part of Applicant cannot be relied upon to distinguish the claimed invention from the prior art of record.

41. Applicant's remaining arguments have already been fully addressed in the preceding paragraphs. The Examiner reiterates that the rejections of record are proper, and Applicant failed to successfully rebut the rejections. Therefore, they are hereby sustained.

42. The Expert's declaration substantially reiterates the same arguments offered in Applicant's remarks, which were fully addressed in paragraphs 1-41 above. Consequently, a separate response is not deemed necessary.

Oath /Declaration

43. The Reissue oath/declaration filed with this application is defective because it fails to identify at least one error, which is relied upon to support the reissue application. Further, it fails to refer to the amendment of 01/05/2002. See 37 C.F.R. 1.175(a) (1), 37 C.F.R. 1.63 (b)(2), and MPEP 1414.

44. Changes made to the certificate of correction have not been incorporated into the specification of the reissue application. Applicant is required to submit a substitute specification, which complies with reissue practice.

45. Claims 1-76 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in paragraphs 43-44 above.

Conclusion

46. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean R. Homere whose telephone number is (703)-308-6647. The examiner can normally be reached on Monday-Friday from 09:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on Monday-Friday from 8:00 a.m. to 3:30 p.m. at (703)-305-9790.

Any response to this action should be mailed to: Commissioner of Patents and Trademarks Washington, D.C. 20231, or faxed to: (703) 746-7239, (for formal communications intended for entry), or faxed to: (703) 746-7238, (for after final communications intended for entry), Or: (703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT"). Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Jean R. Homere
Primary Examiner
Art Unit 2177

April 15, 2003